REMARKS

Claims 1-6, 9-16, 19-26, 29-30 and 32-46 are pending in the application. Claims 7-8, 17-18 and 27-28 have been canceled. Claims 38-46 have been added. A net gain of three dependent claims has been added along with the requisite fee.

Claim Rejections – 35 USC § 103

The Patent Office rejected claims 1-30 and 32-37 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman et al.., U.S. Patent No. 6,288,716, (hereinafter Humpleman) in view of Jones et al., U.S. Patent No. 6,304,523 (hereinafter Jones).

Applicant respectfully traverses the rejection. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.,* 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). In the present application, the prior art does not teach or suggest the combination of Humpleman and Jones, rather, Jones actually teaches away from a combination with Humpleman.

Since the Jones patent teaches away from the combination with the Humpleman patent, the 35 U.S.C. § 103(a) rejection cannot properly be maintained. According to a well established tenet of patent law, a reference cannot be modified in a manner unsatisfactory to its intended purpose. Moreover, if the secondarily cited patent would change the principle of operation of the primarily cited patent, then their combination is improper. These tenets of patent law, promulgated by the Federal Circuit, are stated in MPEP 2143.1 as follows:

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.[1]
>
> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.[2]

The Office Action proposes to combine the Humpleman patent with the Jones patent to show a home network system for automatically retrieving content from a worldwide network relating to a device of the network system or audiovisual media played on a device. However, Jones teaches away from retrieving content from a worldwide network. Jones teaches against the hardware and software associated with communicating with a remote database. (Jones, Column 2, Lines 1-5). The entire scope of Jones is designed to remove the association with a remote database to reduce components, circuitry and cost to have text display with a playback device.

For example, Jones teaches a "recording reproduction apparatus capable of displaying textual information about recordings, obtained from a remote database without requiring a modem." (Jones, Column 2, Lines 9-12). It is well understood that a modem is a device necessary for retrieving content from a worldwide network, consequently, Jones is teaching away from retrieving content from a worldwide network. Further, Jones advocates methods of communication without using a modem, such as using dual-tone multifrequency signals in the communication device to communicate with a remote database (Jones, Column 2, Lines 37-38). Consequently, Jones teaches against retrieving content from a network, precisely an element of claims 1-6, 9-16, 19-26, 29-30 and 32-46 that is not present in Humpleman as stated by the Patent Office on Page 2 of the Office Action of August 27, 2003.

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[1] MPEP 2143.1 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).
[2] MPEP 2143.1 citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Therefore, the combination of Humpleman and Jones is improper since the two cited patents teach away from their combination. Accordingly, withdrawal of the rejection is respectfully requested.

CONCLUSION

In light of the foregoing remarks, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,

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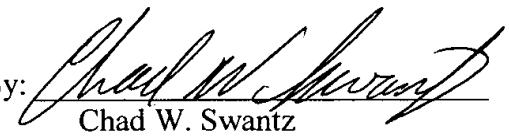
By: 
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